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IN THE

Supreme Court of the United States

OCTOBER TERM, 1959.

No. 522

SENCO PRODUCTS, INC.,

Petitioner,

vs.

FASTENER CORPORATION AND DUO-FAST CO.,

Respondents.

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI.

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OPINIONS BELOW.

The opinions below, which are properly identified in the Petition (p. 2), establish that this is an ordinary patent infringement suit in which the two Lower Courts held invalid Petitioner's patent on a pneumatic hand operated stapling device. The concurrent holdings of invalidity over the prior art are plainly correct. Petitioner's attempt to obtain yet another review of this predominantly factual issue is transparently devoid of merit.

JURISDICTION.

Petitioner's statement of jurisdiction is correct insofar as it refers to 28 U. S. C. Section 1254, but there is no merit in Petitioner's attempt to obtain a review in this Court on the theory that a conflict of decisions of the Courts

of Appeals for the Sixth and Seventh Circuits concerning the validity of the patent in suit should be resolved (Petition, pp. 2, 8 and 9). Respondents submit that this "conflict" is spurious since validity was not contested in the Sixth Circuit. There is, consequently, no reason why the writ prayed for should be granted.

QUESTIONS PRESENTED.

The four abstract questions presented for review by Petitioner include unwarranted assumptions and qualifying fact elements not supported by the decisions below or by the record in this case. Answers to these questions, consequently, can have no bearing on the outcome of this suit.

STATEMENT OF THE CASE.

(a) The Sixth Circuit Litigation.

The Petition predicates jurisdiction upon an alleged conflict between the Courts of Appeals for the Sixth and Seventh Circuits about the validity of the patent in suit. Petitioner's statement concerning the Sixth Circuit case of *Sasser et al.* v. *Senco Products, Inc.*, 242 F. 2d 565 (C. A. 6, 1957) (Petition, App. B., p. 21), affirming, *Senco Products, Inc.* v. *Travis M. Sasser, et al.*, Civil Action No. 3638, Southern District of Ohio, Western Division (A. 501) needs elaboration. The most significant fact of that litigation is that the defendants never raised more than a formal objection to the validity of Patent No. 2,671,214.

The complaint in the Sixth Circuit litigation involved three patents, namely Patent No. 2,671,214 as to which Petitioner here seeks a review by this Court, Patent No. 2,687,522 which was held invalid by the District Court in the Seventh Circuit litigation and as to which Petitioner

took no appeal, and a Reissue Patent No. Re. 23,756 which was not involved in the Seventh Circuit litigation (A. 633-634, Paragraphs 6, 7 and 8). Aside from a general denial of the allegations contained in Paragraphs 6, 7 and 8 of the complaint, based upon a lack of "knowledge or information sufficient to form a belief" as to whether the patents were "duly and legally issued," the answer of defendant Sasser in the Sixth Circuit litigation dealt with the validity question only in Paragraph 28 thereof (A. 657) which rather equivocally reserved the right to plead further upon the defense of invalidity. No such further pleading was ever filed and no prior art was pleaded. When the defense attorney, at the end of the trial, introduced certain prior art references into evidence, he did so merely to show the state of the art (A. 665). Defendants failed to produce expert testimony explaining the state of the art to the Court or demonstrating how the prior art suggested Juilfs' alleged invention. Furthermore, defense counsel made clear that the prior art was of no importance by saying (A. 666):

> "I might say that practically this entire batch of patents are file wrapper references against these Juilfs patents. There are a few additional. They are not worth-while talking about."

It is also noteworthy that the prior art thus introduced in the *Sasser* litigation was quite incomplete. It did not include many of the items which Respondents in the present case put before the Lower Courts. A comparison of the prior art in the two cases shows (A. vi and 628) that Patents No. 451,995 to Bradeen; No. 798,416 to Jackson; No. 863,646 to Rice; No. 931,964 to Scott; No. 1,063,666 to Duryea *et al.*; No. 1,142,671 to Carmina; No. 2,187,692 to Oeckl; No. 2,241,184 to Clark; No. 2,304,650 to Pardee and No. 547,814 (Great Britain) to Hardypick, cited by Respondents and discussed by the Illinois District Court (A. 671) were not offered in the Ohio litigation. Also the

Randall commercial gun and the Fastener Duo-Fast compression tacker CT-800 mentioned by the District Court below (A. 675) were not before the Ohio Court.

In view of these circumstances the finding of validity of Juilfs Patent No. 2,671,214 in the *Sasser* case does not relate to a contested issue but is clearly akin to a consent judgment. *On appeal, validity was expressly conceded* (Petition, App. B., p. 22).

(b) The Seventh Circuit Litigation.

In the Illinois litigation Petitioner's suit against Respondents was based on only two of the patents involved in the Sixth Circuit litigation and differed vastly from the earlier litigation in that the defenses of prior invention and lack of invention were the central theme of the Illinois case. These questions were thoroughly explored and presented to the District Court by testimony in Court, depositions, numerous physical exhibits, explanatory charts and expert testimony. The briefs in the two Lower Courts as well as the published opinions of these Courts were principally concerned with the issue of validity.

The evidence of invalidity was convincing. The District Court held that both of the Juilfs patents were invalid for lack of invention, and although this was contrary to the uncontested holding in the Sixth Circuit, Petitioner did not appeal as to the later of the two patents, No. 2,687,522. The Seventh Circuit Court of Appeals not only held that the District Court's finding of invalidity as to Patent No. 2,671,214 was sustained by the evidence but added (Petition, App. A., pp. 19, 20):

> "The arrangement of the features incorporated by the plaintiff in its device did not possess the 'impalpable something which distinguishes invention from simple mechanical skill.' *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147. These

> features had been employed in other similar types of tools. Their adaptation by plaintiff resulted in an improvement but represents no more ingenuity than the work of a mechanic skilled in the art. There are no 'unusual or surprising consequences from the unification of the elements here concerned' nor did plaintiff's utilization of the features it mentions 'add to the sum of useful knowledge.' *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147."

The Illinois District Court and the Court of Appeals for the Seventh Circuit arrived at the conclusion of invalidity with full knowledge of the result of the *Sasser* case. Petitioner in the Courts below had unsuccessfully stressed the *Sasser* case as an important and persuasive precedent. The District Court answered these arguments correctly by saying (A. 672-673):

> "Senco cites a decision by the Sixth Circuit Court of Appeals, *Sasser et al. v. Senco Products, Inc.*, 242 F. 2d 565 upholding the validity and finding infringement of the patents here in suit. However, the validity of the patents in suit was conceded in that case and therefore, it offers nothing authoritative here. *Murray-Ohio Manufacturing Co. v. E. C. Brown Co.*, 124 F. 2d 426, 428."

The Court of Appeals thought so little of Petitioner's argument on this point that its opinion ignored it completely.

(c) The Nature of the Alleged Invention.

Novelty and patentability of Petitioner's pneumatic stapling tool are urged by Petitioner only as to two features, namely, the piston and driver are separate rather than connected and a separate stop is provided for the piston. It is asserted at pages 5 and 6 of the Petition that this arrangement results in accurately setting the staples without injuring the fabric and reduces driver

breakage. References to the record are absent from this part of the Petition. In fact, there is no supporting evidence in the record about these alleged problems and their solution by Juilfs other than self-serving statements in Juilfs' patents (column 1, lines 41-52; A. 687) and the parroting of these statements by Petitioner's expert (A. 12-16). Firsthand evidence of witnesses experienced in this art establishes that the alleged problems were not encountered in practice and that Juilfs' tool worked no better than pneumatic staplers in which the piston and driver were connected (A. 40-42, 47, 52-53, 82-83). Moreover, tools having only a single stop for the piston and driver, worked equally well (A. 60). The opinion of the Court of Appeals in this case refers to the proper staple setting and reduction of driver breakage not as actual but as "claimed" advantages of the Juilfs arrangement (Petition, App. A., p. 18). Since the patent was held invalid for lack of invention the opinion does not discuss the evidence refuting these claimed advantages.

ARGUMENT

1. There Is No Genuine Conflict Between the Two Courts of Appeals.

Petitioner invokes this Court's jurisdiction on the theory that the present case and the *Sasser* case have created a conflict of decisions which "must be resolved", and on the ground that "The industry is completely up in the air as to whether the patent is valid or invalid." (Petition, p. 9.) Respondents submit that the very opposite is true. If this case presents a conflict of decisions it is not a substantial but a purely formal conflict. The conflict is such that this Court should not resolve it. There is nothing in the record to show that the public or the staple industry, at this time, has any interest in the validity of the Juilfs patent.

Respondents agree that the Court of Appeals in *Sasser et al.* v. *Seneca* (Petition, App. B., p. 23) did not hold the Juilfs patent invalid. It may, however, be doubted whether its decision conflicts with that of the Court below. The articulate concurrent findings of invalidity in the present case were based on a great deal of evidence and argument of counsel. In contrast, the Court of Appeals for the Sixth Circuit at the outset "eliminated from consideration" the question of validity which had been conceded without argument by Appellants' counsel (Petition, App. B., p. 22). Thus, while the blanket affirmance of the judgment in the *Sasser* case may include the District Court's ruling on validity, the case essentially did not involve an appeal of the validity issue. Since the Court of Appeals in *Sasser* actually did not pass on the question of validity, its decision can hardly be said to conflict with that of the Court of Appeals in the present case.

If, however, the general affirmance of the District Court in *Sasser* were to be regarded as technically encompassing validity and conflicting with the Seventh Circuit's holding of invalidity such conflict would be attenuated to such a degree as not to merit solution by this Court. As previously indicated, Petitioner did not consider the "conflict" between the Sixth Circuit and the Illinois District Court of sufficient importance even to warrant an appeal as to Patent No. 2,687,522.

The unsubstantial nature of the conflict is further demonstrated by the way in which the validity issue was presented to and decided by the District Court in the *Sasser* case. The defendants in the Ohio litigation all but conceded validity in the District Court. The defendants' conduct in that case was epitomized in Seneco's brief as follows (A. 630):

> "Defendants did nothing before or at the trial to overcome Plaintiff's prima facie case of patent validity!"

In view of this fact the District Court's holding of validity followed almost as a matter of course from the statutory presumption of Title 35 U. S. C. Section 282 (Petition, p. 4). It was not a ruling on a contested issue.

Moreover, it does not appear that the Ohio Court even considered the defense of "lack of invention" which was sustained in this Seventh Circuit litigation. Instead, the Ohio Court merely held that the prior art patents introduced by defendants in that litigation "do not anticipate any of the claims" (A. 504, Finding 12). With this Respondents agree, but this finding is not in conflict with the Seventh Circuit.

From the above it is clear that any conflict which may exist between the Courts of Appeals for the Sixth and Seventh Circuits is not genuine. It is not the kind of con-

flict envisaged by Rule 19-1(b) of the Supreme Court Rules. That Rule, as stated in *Frankfurter and Hart, The Business of the Supreme Court at October Term, 1933, 48 Harvard Law Review* 238, 268 (1934), contemplates

> "The existence of a square conflict * * * the Court is interested in conflicts which impair uniformity of decision where uniformity is significant. * * *"

Respondents submit that no social interest would be served by resolving the "conflict" between the *Sasser* decision and the present litigation. The *Sasser* decision on its face, as well as upon its record, is most unlikely to be regarded as persuasive in any later case involving the issue of validity. Such cases will follow the Seventh Circuit decision insofar as they may be influenced by precedent. The fact that the Court of Appeals in this case did not even distinguish or comment on the *Sasser* case shows that it did not regard its decision as creating a genuine conflict with the Sixth Circuit. Other courts would unquestionably share this view if the validity of the Juilfs patent should become an issue in any future case.

Finally, it should be observed that Petitioner has not pointed to any instance in which this Court has taken jurisdiction to resolve the kind of conflict here presented. The fact is that certiorari has been denied in patent cases even though a genuine conflict existed. *S. H. Kress & Company v. Elie P. Aahnides, et al.*, 355 U. S. 889, 78 S. Ct. 261 (1957).

Furthermore, this Court has consistently refused to grant petitions for writs of certiorari in patent cases where the conflict was apparent only, rather than real. See *Westinghouse Electric Corporation v. Bulldog Electric Products Company*, Case No. 424, October Term 1953, Certiorari Denied 346 U. S. 909, 74 S. Ct. 240 (1953).

Nor has this Court hesitated to dismiss as improvidently

granted a writ of certiorari where, after full argument on the merits it appeared that there was no *real* conflict between Circuit Courts of Appeals as to the validity of a patent. In *Layne & Bowler Corporation* v. *Western Well Works, Inc., et al.*, 261 U. S. 387, 393, 43 S. Ct. 422, 423 (1923), this Court in dismissing the writ said that certiorari should not be granted

> "* * * except in cases involving principles the settlement of which is of importance to the public, as distinguished from that of the parties; and in cases where there is a real and embarrassing conflict of opinion and authority between the Circuit Courts of Appeals."

Certainly there is no real and embarrassing conflict here, since the Sixth Circuit Court of Appeals did not consider or decide any contest as to whether the Juilfs patent was valid or invalid. The *Layne & Bowler* case was quoted from and cited with approval as recently as *Rice* v. *Sioux City Memorial Park Cemetery Inc., et al.*, 349 U. S. 70, 79, 75 S. Ct. 614, 619 (1955).

2. The Patent in Suit Is Invalid and Was Found to Be Invalid for Lack of Invention Regardless of How the Questions Presented in the Petition Should Be Answered.

The questions submitted by Petitioner are singularly unsuited for determination by this Court against the factual backdrop of the instant case. These questions are synthetic and unreal. As phrased by Petitioner they all include qualifying elements not present in this suit which make the answers to Petitioner's questions obvious as well as irrelevant. Thus, question No. 1 assumes that the District Court used an incorrect standard of invention; question No. 2 asks whether the Court of Appeals may act "arbitrarily"; question No. 3 assumes, contrary to the

facts, that Juilfs' patent achieved substantial commercial success; and question No. 4 assumes, contrary to uncontradicted expert testimony, that the Court of Appeals misunderstood the prior art.

Thus merely formal analysis of Petitioner's questions shows their lack of substantiality. A short analysis of the course of the litigation and the meaning of the decisions below will demonstrate further that the petition presents nothing deserving the attention of this Court.

The central problem before the Lower Courts was whether the slightly improved combination claimed by Juilfs contributed enough to the art to deserve patent protection. On this question both Courts examined the prior art introduced and explained by Defendants. Both Courts correctly understood the operation of the structure claimed by Juilfs. Both Courts concluded that Juilfs Patent No. 2,671,214 was invalid for lack of invention. The District Court expressed its holding as follows (A. 677-678):

> "When this operation is considered in light of the basic teachings of the Bradeen patent and of the whole field of staple driving and percussion type tools, the familiarity is apparent. The operation bears the unmistakable stamp of improvement and development **which is the result of mechanical skill only.** Nowhere in the operation can I find the flash of creative genius which is necessary to constitute invention. *Cuno Engineering Corporation* v. *Automatic Devices Corporation*, 314 U. S. 84. The utility and commercial success of the '214 patent cannot create patentability where invention is lacking. *Great Atlantic and Pacific Tea Co.* v. *Supermarket Equipment Corporation*, 340 U. S. 147. Therefore, I hold the '214 patent invalid for lack of invention." (Emphasis added.)

The citation of the *Cuno* case and the use of the words "flash of creative genius" were seized upon by Petitioner to urge to the Court of Appeals that the District Court's

finding of invalidity resulted from the application of an incorrect standard of invention. Clearly the passage quoted does not support this charge. It is equally clear that the Court of Appeals was not bound to discuss each argument advanced by Appellant and committed no error in refusing to comment on Appellant's disingenuous contention about the standard of invention. The Court of Appeals agreed with the holding that the Juilfs patent was uninventive over the prior art and Petitioner has no quarrel with the standard of invention applied by the Court of Appeals. Consequently, the affirming opinion's silence about the standard of invention can not have been prejudicial to Petitioner's case and should not be reviewed on certiorari.

The concurrent findings of invalidity are clearly correct in view of the prior art. Petitioner's assertion that the prior art was misunderstood involves a question of fact not suited for review by this Court. Moreover, the opinion of the Court of Appeals affirmatively shows that it made no mistake about the three prior art items to which Petitioner directs the attention of this Court.

With respect to the Randall commercial gun the Court of Appeals said (Petition, App. A, p. 19):

> "* * * there was a loose connection between the piston and driver * * *"

This is in accord with the uncontradicted testimony of Defendants' expert (A. 68). About the same item Petitioner says that (Petition, p. 12):

> "* * * the connection between the driver and the piston is characterized by a few thousandths of an inch of play. * * *"

In substance these two statements agree.

Discussing Von Vass Patent No. 1,186,458 (A. 801-805) the Court below stated (Petition, App. A, p. 19):

> "The Von Vass patent 1,186,458 covering a nailing device employed a piston which was separate from the driver. The piston was stopped independently of the driver. A spring served as a stop for the driver."

This is accurate, and again is in strict accord with the uncontradicted testimony of Defendants' expert (A. 63). Petitioner's suggestion that the contrary can be shown by "measuring" the figures of the patent drawings was rejected *sub silentio* by the Court of Appeals.

Finally, with respect to Carmina Patent No. 1,142,671 (A. 792-800) the Court of Appeals correctly said (Petition, App. A, p. 19):

> "The Carmina patent 1,142,671 disclosed a construction in which a recessed piston is arranged to receive and drive a separate driver, provisions being made for separate stops, for the piston and driver."

Defendants' expert witness described the Carmina structure in detail (A. 71) and the Court's understanding, as expressed above, is strictly in accordance with his explanation. Contrary arguments of Petitioner's counsel, without supporting testimony, cannot establish any mistake by the Court of Appeals. It is thus clear that the prior art was correctly analyzed by the Court of Appeals and that it fully supports the holding of invalidity.

Petitioner further contends (Petition, p. 10) that the opinion below is erroneous because of the following statement (Petition, App. A, p. 20):

> "The presumption of validity arising from the grant of a patent does not exist as against prior art not before the Patent Office. *Hobbs* v. *Wisconsin Power & Light Company*, 250 F. 2d 100, 105. Of the aforesaid prior art relied upon by the defendants only Randall and Pardee patent 2,304,650 were before the Patent Office."

The rule enunciated in the above passage is universally

recognized.* The failure of the Patent Office to cite *pertinent* references against an application greatly impairs the presumption of validity of the patent issuing upon such an application. *Adler Sign Letter Co., et al.* v. *Wagner Sign Service, Inc.*, 112 F. 2d 264, 267 (C. C. A. 7, 1940) does not conflict with the above rule, but merely limits it to the Patent Office's failure to cite *pertinent* prior art. Since the references on which the Courts below invalidated the Juilfs patent were highly pertinent, it cannot reasonably be presumed that the Patent Office was aware of them but did not consider them worth citing. The following passage from *Nordell, et al.* v. *International Filter Co.*, 119 F. 2d 948, 950 (C. C. A. 7, 1941) convincingly states the reasons for the rule:

> "There was considerable prior art not cited by the Examiner, **which we think is quite pertinent.** Among this prior art were certain German publications which clearly described the comminution of solids in liquids without removing the solids from the stream. * * * **This accomplishment was precisely what Nordell told the Examiner was new in the art,** and there can be no presumption of validity over this prior art which the Examiner did not note. We are here confronted with a **strange doctrine,** that the fact that the Examiner did not mention this art raised no presumption that he did not see it and consider it. But on the other hand, appellees urge that it raises a presumption that the Examiner was aware of it and did not consider it applicable. **We do not understand this to be the law.**" (Emphasis added.)

* *H. Schindler & Co., Inc.* v. *C. Saladino & Sons, Inc.*, 81 F. 2d 649, 651 (C. C. A. 1, 1936); *Zoomar, Inc.* v. *Paillard Products, Inc.*, 258 F. 2d 527, 530 (C. A. 2, 1958); *Dole Refrigerating Company* v. *Amerio Contact Plate Freezers Inc.*, 265 F. 2d 627, 629 (C. A. 3, 1959); *Gillette Safety Razor Co.* v. *Cliff Weil Cigar Co. Inc.*, 107 F. 2d 105, 107 (C. C. A. 4, 1939); *Cornell et al.* v. *Adams Engineering Company, Inc.*, 258 F. 2d 874, 875 (C. A. 5, 1958); *Royal Patent Corp. et al.* v. *Monarch Tool & Mfg. Co.*, 203 F. 2d 299, 300 (C. A. 6, 1953); *Hobbs* v. *Wisconsin Power & Light Company*, 250 F. 2d 100, 105 (C. A. 7, 1957); *Rohr Aircraft Corporation et al.* v. *Rubber Teck, Inc. et al.*, 266 F. 2d 613, 617-618 (C. A. 9, 1959).

The Court of Appeals concluded its opinion saying (Petition, App. A, p. 20):

> "We hold the patent invalid for lack of invention. Consideration of commercial success is therefore irrelevant. *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147."

Petitioner's contention that this was prejudicial error is untenable for two reasons.

It is well established that commercial success becomes relevant only if the question of validity is in doubt. The cases cited by Petitioner (Petition, p. 11) so hold. Since both Lower Courts were firmly convinced that the Juilfs patent was the result of mere mechanical skill, the alleged commercial success could not lead to a reversal of the District Court. The second reason why commercial success could not influence the ruling on validity is the lack of substantial evidence on this point.

Conclusion.

For the foregoing reasons it is respectfully submitted that the Petition should be denied.

Respectfully submitted,

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